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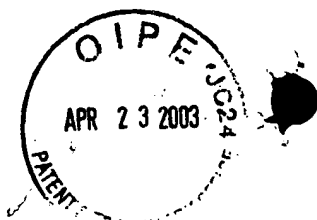
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Total Number of Pages in This SubmissionENCLOSURES (check all that apply)

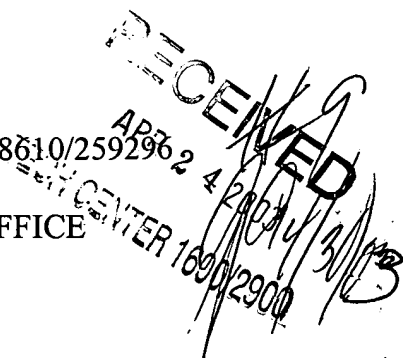
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Attorney Docket No.: H8610/2592962 4



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Gareth Williams *et al.*

Serial No.: 09/856,938

Art Unit: 1616

Filed: January 18, 2002

Examiner: Pryor

For: WOOD PRESERVATIVE  
FORMULATIONS

Assistant Commissioner for Patents  
Washington, DC 20231

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**RESPONSE TO RESTRICTION REQUIREMENT**

Sir:

In response to the Office Action mailed on March 20, 2003, Applicants submit the following.

The Examiner alleges that the invention contains claims directed to distinct species of numerous methods and compositions, but fails to specify what these are. Instead, without informing Applicants of which species the Examiner considers to be patentably distinct, the Examiner requires that Applicants elect a single composition, specifying a single oxathiazine compound, one or more quaternary ammonium compounds, and a single triazole compound.

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**CERTIFICATE OF MAILING (37 CFR 1.8a)**

I hereby certify that this correspondence, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service on April 18, 2003 with sufficient postage as first-class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231.

Merle H. Westbrook

Then the Examiner goes on to require that if any "additional ingredients" are present, these must also be specified, and if they are not, the Examiner threatens to classify any claims that further limit the claimed compositions or methods by specifying additional ingredients as nonelected claims.

Applicants elect the species of compositions and methods wherein the oxathiazine is bethoxazin (i.e., 3-(benzo[b]thien-2-yl)-5,6-dihydro-1,4,2-oxathiazine-4-oxide) and that also contain the triazole cyproconazole (i.e., ((2RS,3RS; 2RS,3SR)-2-(4-chlorophenyl)-3-cyclopropyl-1-(1H-1,2,4-triazol-1-yl)butan-2-ol)). In the event that this election is not specific enough for the Examiner, Applicants elect the composition of Example 2.

This election is made with traverse, however. The Examiner's implication that he will only examine compositions having the two elected components, and will not examine other compositions that comprise these two components and also contain other components, while a creative way of limiting the Examiner's workload, is contrary to well established case law. See *In re Weber*, 198 USPQ 328 (CCPA 1978); *In re Haas*, 198 USPQ 334 (CCPA 1978). In effect, the Examiner is using election practice to force Applicants into what amounts to "consisting essentially of" terminology, without citation of any prior art. This is clearly the type of "rejection" using 35 U.S.C. § 121 that was forbidden by the cited cases. The Examiner should withdraw his election requirement, and examiner all of the scope of the

U.S.S.N.: 09/856,938  
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For: Wood Preservative Formulations  
RESPONSE TO RESTRICTION REQUIREMENT

claims on the merits. At minimum, the Examiner should treat the claims in accordance with the provisions of MPEP 803.02.

Please charge any fees in connection with this filing to Deposit Account No. 11-0855.

Respectfully submitted,



Bruce D. Gray  
Reg. No. 35,799

Date: April 18, 2003

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